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Docket No.: SHG-0047  
(PATENT)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re Patent Application of:  
Jun Akikusa et al.

Confirmation No.: 8796

Application No.: 09/891,501

Art Unit: 1745

Filed: June 27, 2001

Examiner: R. Alejandro

For: SOLID OXIDE FUEL CELL

**RESPONSE TO NOTICE OF NON-COMPLIANT AMENDMENT**

MS Amendment  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

**REMARKS**

In response to the Notice of Non-Compliant Amendment dated May 21, 2004,  
Applicants wish to state the following:

A Request for Continued Examination (RCE) along with a Preliminary Amendment was filed on May 17, 2004. The only claim amendments submitted with the RCE are those claim amendments not previously entered by the examiner, which is fully compliant. The papers submitted concurrently with the RCE does not make claim amendments, therefore a listing of the pending claims with status identifies is not needed nor required. A copy of the previously filed Amendment with a stamped postcard is attached hereto. It can readily be seen that the only claims the Notice of Non-Compliance could possibly be referring to is a translation referred to in the Declaration of the inventor. As these claims are not the claims under examination, no status identifies are presented nor required.

Applicants hereby submit this Response, which should satisfy the Notice of Non-Compliant Amendment mailed May 21, 2004. Accordingly, this Response to Notice of Non-Compliant Amendment, along with the RCE and papers filed May 17, 2004, should proceed to the examiner.

Additionally, as this reply is within one month of the date of the Notice, NO FEES ARE PRESENTLY DUE.

Dated: June 14, 2004

Respectfully submitted,

By 

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4 (prior art presented) A solid oxide **REMARKS** according to Claim 1 wherein:

This is in full and timely response to the final Office Action mailed June 23, 2003 and the Advisory Action mailed October 9, 2003, submitted concurrently with a Petition for a 2 month extension of time. Entry of this Amendment is proper under 37 C.F.R. §1.116 since the amendment: (a) places the application in condition for allowance (for the reasons discussed herein); (b) does not raise any new issues requiring further search and/or consideration; (c) satisfies a requirement of form asserted in the previous Office Action; and (d) places the application in better form for appeal, should an appeal be necessary. The amendment is necessary and was not earlier presented because it is made to correct a typographical error. Entry of this amendment is respectfully requested. Reexamination and reconsideration in light of the above amendments and the following remarks is respectfully requested.

Applicants want to thank SPE Patrick Ryan for the courtesies extended during the October 15, 2003 telephone discussion. Claim 1 and the corresponding portion of the specification were amended to more clearly recite the translation from the priority document.

Applicants' retrieved the computer translation of the priority document from the Japanese Patent Office web site. Paragraph 12 was translated as:

[0012] invention which invention concerning a claim 2 requires for a claim 1 -- it is -- the [ the 1st and ] -- 2 electrolyte layers 16a and 16b --  $\text{La}_{1-a}\text{AaGa}_{1-(b+c)}\text{BbCo}_3\text{O}_3$  it constitutes from material shown, respectively -- having -- the [ and ] -- or [ that the **cobalt addition of 1 electrolyte layer 16a is zero** ] -- the [ or ] -- it is the solid-acid ghost type fuel cell which is **80% or less of the cobalt addition of 2 electrolyte layer 16** However, for the inside A of a formula, it is one sort or two sorts or more of elements of Sr, calcium, and Ba, B is one sort or two sorts or more of elements of Mg, aluminum, and In, a is 0.05-0.3, b is 0-0.3, c is 0-0.2, and (b+c) is 0.025-0.3. As shown in drawing 2, it is the ion transference number of a lanthanum gallate system oxide. (ionicity conduction occupied to electric conduction comparatively) It changes especially with c value, and if c value is low, the ion transference number will improve. On the other hand, if c value is large by the upper formula, although conductivity is high, the ion transference number becomes low. In invention concerning this claim 2, 1st electrolyte layer 16a with the high ion transference number is obtained comparatively easily and certainly as compared with 2nd electrolyte layer 16b by making the **cobalt addition of 1st electrolyte layer 16a smaller than the cobalt addition of 2nd electrolyte layer 16b**. (Emphasis added)

Likewise, claim 2 of the priority document was translated as:

REMARKS

[Claim 2] the [ the 1st and ] -- 2 electrolyte layers (16a, 16b) --  $\text{La}_{1-a}\text{AaGa}_{1-(b+c)}\text{BbCoO}_3$  it constitutes from material shown, respectively -- having the [ and ] -- or [ that the cobalt addition of 1 electrolyte layer (16a) is zero ] -- the [ or ] -- solid acid ghost type fuel cell according to claim 1 which is 80% or less of the cobalt addition of 2 electrolyte layers (16b) However, for one sort of Mg, aluminum, and In or two sorts or more, and a, 0.05 to 0.3 and b are [ the inside A of a formula / one sort of Sr, calcium, and Ba or two sorts or more, and B / zero to 0.2 and (b+c of zero to 0.3 and c) ] 0.025-0.3. (Emphasis added)

As you can see this computer translation is difficult to interpret with respect to the percentage amounts of cobalt in the first electrolyte compared to the second electrolyte.

The English language abstract recites, in the last sentence:

Each electrolyte layer is made of a material as expressed by the formula,  $\text{La}_{1-a}\text{AaGa}_{1-(b+c)}\text{BbCoO}_3$ , and the added quantity of cobalt of the first electrolyte layer is smaller than the added quantity of cobalt of the second electrolyte layer, and the thickness of the first electrolyte layer is 1 to 20% of the solid electrolyte layer.

Upon review of the original Japanese, applicants believe that the amount of cobalt in the first electrolyte layer can be translated as  $0\% \leq \text{Co} \leq 80\%$  with respect to the amount of cobalt in the second electrolyte layer.

Accordingly, applicants have amended claim 1, and the appropriate portion of the specification, to reflect this translation.

Rejections under 35 U.S.C. §103

Claims 1 and 3-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,287,716 to Hashimoto et al. Applicants respectfully traverse this rejection.

Hashimoto et al. '716 is not a proper §102(e)/103 reference because Hashimoto et al. '716 has the same assignee as this Application.

The MPEP at 2136.01 states:

For applications filed on or after November 29, 1999, a provisional rejection under 35 U.S.C. 102(e)/103 is not proper if the application contains evidence that the application and the prior art reference were

owned by the same person, or subject to an obligation of assignment to

(10) the same person, at the time the invention was made. (b)(1) -- La1-xAa (1-b)(c)

Be Co. O. It is estimated that the material showing, respectively -- having -- the [and] -- or [

Similarly, MPEP §2136.02 states that

For applications filed on or after November 29, 1999, if the applicant provides evidence that the application and the prior art reference were owned by the same person, or subject to an obligation of assignment to the same person, at the time the invention was made, any rejections under 35 U.S.C. 102(e)/103 based upon such a commonly owned reference should not be made or maintained.

Evidence required to establish common ownership by the applicant is discussed in MPEP §706.02(l)(2), which states that a statement can be made by an attorney of record, and that the statement concerning common ownership should be clear and conspicuous, for example, on a separate piece of paper or in a separately labeled section. Furthermore, Applicant may, but is not required to, submit further evidence, such as assignment records.

As discussed above, §1.131 or §1.132 affidavits are inappropriate to overcome this rejection.

#### **Statement of Common Ownership**

Application 09/891,501, filed June 27, 2001, and U.S. Patent No. 6,287,716 to Hashimoto et al., were, at the time the invention of Application 09/891,501 was made, owned by Mitsubishi Materials Corporation of Japan.

Accordingly, withdrawal of these rejections is respectfully requested.

owned by the same person, or subject to an obligation of assignment to the same person, at the time the invention was made.

**Conclusion**

Similarly, MPEP §2135.02 states that

For the foregoing reasons, claims 1 and 3-6 are allowable, and the present application is in condition for allowance. Accordingly, favorable reexamination and reconsideration of the application in light of these amendments and remarks is courteously solicited. If the examiner has any comments or suggestions that would place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number below.

Dated: November 18, 2003

Respectfully submitted,

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Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 180013 for any such fees; and applicant(s) hereby petition for any needed extension of time.